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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/035,264 02/20/02 COATES

J IAF-14

EXAMINER

12M1/0915

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ART UNIT	PAPER NUMBER
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1202

DATE MAILED: 09/15/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 07/20/02 This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 3, 4, 5, 7, 10, 14 and 20 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 3, 4, 5, 7, 10, 14 and 20 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

PTOL-200 (rev. 9-89)

Art Unit 1202

Applicants response of July 26, 1993, is noted.

The claims in the application are claims 3, 4, 5, 7, 10, 19 and 20.

Claims 3, 4, 5, 7, 10, 19 and 20 are rejected under 35 U.S.C. 102 and 103. Applicants describe ^{on} page 1 of their specification that the present compound exists as a racemate. The (-) enantiomer here claimed is included in the (+) mixture of the racemate. See *Eli Lilly & Co. vs. Generic Drug Sales*, 169 USPQ 13, and *In re Adamson*, 125 USPQ 233.

Applicants appear to *argue* that the present (-) enantiomers possess an unexpected activity, on page 3 of their response, over the known \pm racemic.

No declaration to that effect is noted in the record here.

Applicants appear to agree on page 5 of their response that methods existed for separating out the enantiomerically pure form.

The rejection of claims 19 and 20 continues under 35 USC 112, 1st and 2nd paragraphs. The expression pharmaceutically acceptable derivative reads on any unknown derivative.

Art Unit 1202

Applicants response is noted, but the claims measure the invention. Applicants have claimed in an open manner that cannot be supported in the specification by adequate representative exemplification, as there is no limit as to what this unknown derivative might be.

The fact that this language may have appeared in another patent does not mean that it should be allowed here; In re Greider, 54 USPQ 139.

Some unknown residue reads on "derivative", and could not be allowed here. Applicants example 4 at the top of page 10 of their response indicates the staggering, unknown, breadth of "derivative".

Claim 3 still calls for 5% (+) isomer. Therefore, mixtures of (+) & (-) enantiomers are still claimed here.

Belleau, U.S. Patent 5,047,407, and WO 91/11186 (Liotta) are presumably indications of the prior art that indicates the compound claimed here is known. See claim 1 of Belleau et al. Note Liotta, notes "enantiomerically-enriched in claims 66-72.

Claims 3-5, 7, 10, 19 and 20 are rejected under 35 USC 102 and 103 as being unpatentable over Belleau et al. U.S. Patent 5,047,407. Note Reaction Scheme 1, compound XII. The present isomers would be included with the disclosure of that compound. Note in claim 1, Z is S. In the first instance of R² of claim 1, which claims all optical isomers of their compounds the present

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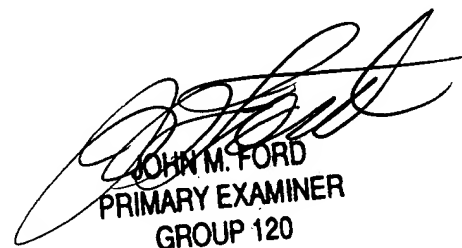
Art Unit 1202

pyrimidine is set forth and claimed when R³ and R⁴^{are} hydrogen.

Claims 3-5, 7, 10, 19 and 20 are rejected under 35 USC 102 and 103 as being unpatentable over Liotta et al., U.S. Patent 5,204,466. Note the present compound is described in Liotta as ~~B~~-BCH-189 and its analogs in formula 6 and formula 14. Note the reference to enantiomerically enriched. In col. 4.

Any inquiry concerning this communication should be directed to Examiner Ford at telephone number (703) 308-4721.

Ford: ach
September 15, 1993


JOHN M. FORD
PRIMARY EXAMINER
GROUP 120